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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|---|-------------|----------------------|----------------------------|------------------------|
| 10/666,866  | 09/19/2003  | James R.W. Phillips  | XTEN-1-1015                | 8477                   |
| 25315 7590 10/03/2007<br>BLACK LOWE & GRAHAM, PLLC<br>701 FIFTH AVENUE<br>SUITE 4800<br>SEATTLE, WA 98104 |             |                      | EXAMINER<br>MYHRE, JAMES W |                        |
|   |             |                      | ART UNIT<br>3622           | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>10/03/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/666,866 | <b>Applicant(s)</b><br>PHILLIPS ET AL. |  |
|                              | <b>Examiner</b><br>James W. Myhre    | <b>Art Unit</b><br>3622                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response to the initial filing on September 19, 2003.

Claims 1- 24 are currently pending and have been considered below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 3 recites the limitation "a second item" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 is dependent from Claim 1. The last line of Claim 1 includes "offering a discount for the purchase of **a second item**" (emphasis added). Claim 3 adds "receiving from a customer a selection of **a second item** being offered for sale". It is unclear whether the second item in Claim 3 is the same second item as identified in Claim 1, or whether it is actually a third item. The Examiner will assume that the two items are the same item when considering the claims below. It is suggested that the Applicant changes Claim 3 to read "the second item" to clarify the limitation.

5. Claim 22 is shown as being dependent upon Claim 19. However, Claim 19 limits the calculation of the discount to being based on the price of the first item. Claim 22 limits the same calculation of the discount to being based on the price of the second item. It is unclear, and the Examiner finds no reference in the specification, as to how one would base the discount on both prices. It appears the Applicant "cut-and-pasted" this claim from Claim 20 without changing the dependency to Claim 21. Therefore, the Examiner will consider Claim 22 to be dependent upon Claim 21 below.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al (6,119,099).

Examiner's Note: It appears that the Applicant is attempting to invoke 35 U.S.C. 112, 6<sup>th</sup> paragraph by using means-plus-function language in Claims 17-24 ("means for receiving", "means for calculating", "means for submitting", etc.). In order to successfully invoke the 6<sup>th</sup> paragraph, a claim must pass a three-prong test. First, the claim itself must contain means-plus-function language. Second, the claim must not

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contain structural limitations to the means. Third, the specification must explicitly point out and define the physical structural limitations of the means. While the above claims pass the first of the three prongs by using "means for receiving" etc., the claims do not pass the second of the three prong test by including the structural limitation in the preamble of Claim 17 that the means are instructions (i.e. a computer program). Thus, none of the claims successfully invoke the 6<sup>th</sup> paragraph. Therefore, the Examiner will consider the claimed means as any physical or virtual means for performing the related function.

Claim 17: Walker discloses a computer readable medium containing computer instructions for performing steps, comprising:

- a. receiving a request to purchase a first item from a customer (column 2, lines 19-44 and column 6, lines 5-13);
- b. calculating a discount on a second item (column 2, lines 19-44 and column 6, lines 30-54);
- c. receiving a request and confirmation to purchase the second item (i.e. acceptance of the offer by the customer)(column 2, lines 19-44 and column 6, lines 30-54); and
- d. fulfilling the order to complete the purchase of the first and second items in accordance with the order (column 2, lines 19-44 and column 6, lines 30-54).

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Claim 18: Walker discloses a computer readable medium as in Claim 17 above, and further discloses displaying information relating to the first item to the customer (column 2, lines 19-44 and column 6, lines 30-54).

Claim 19: Walker discloses a computer readable medium as in Claim 17 above, and further discloses calculating a discount for the second item based on the first item (column 2, line 19-44 and column 6, lines 30-54).

Claim 20: Walker discloses a computer readable medium as in Claim 19 above, and further discloses calculating a discount for the second item based on the price of the first item (column 2, lines 19-44 and column 6, lines 30-54).

Claim 21: Walker discloses a computer readable medium as in Claim 17 above, and further discloses calculating a discount for the second item based on the identity of the second item (column 2, lines 19-44 and column 6, lines 30-54).

Claim 22: Walker discloses a computer readable medium as in Claim 19 (21) above, and further discloses calculating a discount for the second item based on the price of the second item (column 2, lines 19-44 and column 6, lines 30-54).

Claim 23: Walker discloses a computer readable medium as in Claim 17 above, and further discloses displaying information relating to the second item to the customer (column 2, line 19-44 and column 6, lines 30-54).

Claim 24: Walker discloses a computer readable medium as in Claim 17 above, and further discloses displaying information including the price of the first and second items and the discount to the customer (column 2, lines 19-44 and column 6, lines 30-54).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6,119,099) in view of Swartz et al(6,837,436).

Claims 1 and 9: Walker discloses a system and method, comprising:

- a. receiving a request to purchase a first item from a customer (column 2, lines 19-44 and column 6, lines 5-13); and
- b. offering a discount for the purchase of a second item (column 2, lines 19-44 and column 6, lines 30-54).

Walker discloses a merchant offering one or more items for sale to the customer, but does not explicitly disclose offering the items via an Internet server. However, Swartz discloses a similar system and method for offering a discount for a second item via an Internet server (column 10, lines 23-49; column 12, line 32 – column 13, line 34; and column 33, lines 56-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Walker to include “virtual” merchants (i.e. merchants on the Internet) as the selling entities. One would have been motivated to present the items and to complete the transaction over the Internet in order to expand the realm of potential customers and in view of Walker’s disclosure that the point-of-sale terminal may be “many types of POS terminals, besides those requiring cashiers” (column 13, lines 65-67).

Claims 2 and 10: Walker and Swartz disclose a system and method as in Claims 1 and 9 above, and Walker further discloses calculating a discount for the second item based on the first item (column 2, line 19-44 and column 6, lines 30-54).

Claims 3 and 11: Walker and Swartz discloses a system and method as in Claims 1 and 9 above, and Walker further discloses receiving a selection of the second item (i.e. acceptance of the offer by the customer) and supplying the second item price (column 2, lines 19-44 and column 6, lines 30-54).



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Claims 4 and 12: Walker and Swartz disclose a system and method as in Claims 3 and 11 above, and Walker further discloses calculating a discount for the second item based on the price of the second item (column 2, lines 19-44 and column 6, lines 30-54).

Claims 5 and 13: Walker and Swartz disclose a system and method as in Claims 3 and 11 above, and Walker further discloses receiving a request to purchase the second item (i.e. acceptance of the offer by the customer) and compiling the purchase order for the first and second items(column 2, lines 19-44 and column 6, lines 30-54).

Claims 6 and 14: Walker and Swartz disclose a system and method as in Claims 5 and 13 above, and Walker further discloses applying the discount to the order (column 2, lines 19-44 and column 6, lines 30-54).

Claims 7 and 15: Walker and Swartz disclose a system and method as in Claims 6 and 14 above, and Walker further discloses presenting the compiled order to the customer and receiving confirmation from the customer (column 2, lines 19-44 and column 6, lines 30-54).

Claims 8 and 16: Walker and Swartz disclose a system and method as in Claims 5 and 14 above, and Walker further discloses submitting the order for fulfillment to complete the purchase (column 2, lines 19-44 and column 6, lines 30-54).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Oneda (6,142,371) discloses a system, method, and program for offering a discount on a second item based on the purchase of a first item.

b. Peirce et al (6,332,126) discloses a system, method, and program for offering discounts based on the purchase of a first item. The discounts may be on the first item or on one or more additional items.

c. Inamitsu et al (6,367,696) discloses a system, method, and program for applying a discount on an item based on previous purchases of that item.

d. Jacoves et al (6,741,968) discloses a system, method and program for offering discounts for items based on the purchase of triggering items.

e. Chatani (6,792,292) discloses a system, method, and program for presenting discount offers on a portable device used by a customer while shopping.

f. Pointeau et al (6,892,180) discloses a system, method, and program for delivering discount coupons based on the purchase of triggering items.

g. Kakuta (7,072,860) discloses a system, method, and program for presenting discount offers to a customer while the customer is shopping in an electronic shopping mall.

h. Phillips et al (7,110,960) discloses a system, method, and program for offering discounts on products and services based on the forecasted revenue.

i. Samson et al (7,228,287) discloses a system, method, and program for providing online incentives to a customer based on the customer's purchases.

j. Shanman et al (7,231,357) discloses a system, method, and program for providing targeted discount coupons over a network based on the items selected for purchase by the customer.

k. Schwartz et al (7,236,944) discloses a system, method, and program for providing discounts based on purchase volumes, total price, etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

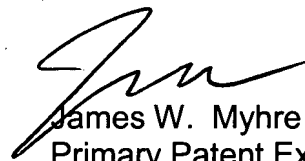
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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JWM  
September 24, 2007



James W. Myhre  
Primary Patent Examiner